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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/630,345	07/29/2003	Joseph A. Zupanick	067083.0205	9309

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EXAMINER

KRECK, JOHN J

ART UNIT	PAPER NUMBER
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3673

DATE MAILED: 04/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/630,345

Applicant(s)

ZUPANICK, JOSEPH A.

Examiner

John Kreck

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 30 December 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 26-62 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 26-62 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 9/13/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

The amendment dated 12/30/04 has been entered.

Claims 26-62 are pending.

The terminal disclaimer filed on 12/30/04 has been reviewed and is accepted.

The terminal disclaimer has been recorded. The double patenting rejections over the issued patents have been withdrawn. The double patenting rejections over the copending applications remain.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

1. Claims 26-58 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims of copending Application No. 10/641,856; 10/323,192, and 10/256,412. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are generally similar in scope or somewhat broader.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 35, 38-39, 54 are rejected under 35 U.S.C. 102(b) as being anticipated by Stanley (United States Patent number 5,411,104).

Stanley teaches a process including drilling a well including a horizontal bore in a coal seam and reducing downhole pressure as called for in claim 35. See col. 3, line 32 for the liquid.

Stanley teaches the coal is porous and fractured as called for in claim 38.

Regarding independent claim 39:

Stanley teaches the drilling and producing gas as called for in claim 39. See col. 3, line 32 for the liquid.

Regarding independent claim 54:

Stanley teaches the drilling a horizontal bore in a coal formation and lightening hydrostatic pressure as called for in claim 54. See col. 3, line 32 for the liquid.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 40, 42, 43, 44, 45, and 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith (U.S. Patent number 5,435,400) in view of Stanley.

Smith teaches a method including drilling and pumping. Smith fails to explicitly teach the coal seam, but discloses that the method is useful to obtain gas.

Stanley teaches that coal seams are advantageously drilled to obtain gas. It would have been obvious to one of ordinary skill in the art at the time of the invention to have practiced the process in a coal seam as called for in claim 40, in order to obtain gas.

Smith teaches the pumping through a second bore (second bore is 2, first bore is 34) as called for in claim 42.

Smith teaches that the second bore comprises a vertical bore as called for in claim 43.

Smith teaches the first bore is articulated as called for in claim 44.

Smith also teaches the main horizontal (e.g. 34) and plurality of laterals (e.g. 52, and 41) as called for in claim 45.

Smith also teaches the gas lift as called for in claim 49.

3. Claims 40, 41, 46, 48, 50, and 61 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mueller, et al. (U.S. Patent number 5,355,967) in view of Stanley.

Mueller teaches the drilling and pumping, but fails to teach the coal seam. Stanley teaches that coal seams are advantageously drilled to obtain gas. It would have been obvious to one of ordinary skill in the art at the time of the invention to have practiced the process in a coal seam as called for in claim 40, in order to obtain gas.

Mueller teaches the pressure is reduced as called for in claim 41.

Mueller teaches a pressure of 100psi (col. 4, line 10) as called for in claim 46.

Mueller teaches the downhole pump (jet pump) as called for in claim 48.

Mueller teaches the absence of loss of fluids as called for in claim 50.

Regarding new claim 61: Mueller clearly teaches drilling mud.

4. Claims 40, 42, 43, 51, and 52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Allen (U.S. Patent number 4,134,463) in view of Stanley.

Allen teaches drilling and pumping, but fails to teach the coal seam. Stanley teaches that coal seams are advantageously drilled to obtain gas. It would have been obvious to one of ordinary skill in the art at the time of the invention to have practiced the process in a coal seam as called for in claim 40, in order to obtain gas.

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Allen teaches the pumping through a second bore as called for in claim 42.

Allen teaches that the second bore comprises a vertical bore (e.g. near 24) as called for in claim 43.

Allen teaches the junction as called for in claim 51.

Allen teaches the cavity as called for in claim 52. Note that the bore at the bottom of well 18 is a "cavity", even though it is not enlarged.

5. Claims 26, 27, 31, 32, 33, 34, 47, and 54-56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mueller in view of Stanley.

Mueller teaches a method of drilling a well including pumping and reducing pressure. Mueller does not specify a specific formation type for the drilling method and thus fails to explicitly teach the drilling in a coal seam, but teaches that the method is useful to prevent overbalanced well problems.

Stanley teaches that overbalanced well problems are common in drilling coal seams; and teaches that it is desirable to drill in coal seams to obtain gas.

It would have been obvious to one of ordinary skill in the art at the time of the invention to have used the Mueller process in a coal seam, in order to obtain gas, as called for in claim 26.

Mueller teaches the lightening the pressure of the fluid as called for in claim 27.

Mueller teaches the pumping with a downhole pump as called for in claim 31.

Mueller teaches the reducing pressure to nearly zero as called for in claim 32.

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Mueller teaches the below overbalanced conditions as called for in claim 33.

Mueller teaches the reducing the pressure to approximately 150-200 psi as called for in claim 34.

Regarding claim 47, which depends form claim 40:

Mueller does not specify a specific formation type for the drilling method and thus fails to explicitly teach the drilling in a coal seam, but teaches that the method is useful to prevent overbalanced well problems.

Stanley teaches that overbalanced well problems are common in drilling coal seams; and teaches that it is desirable to drill in coal seams to obtain gas.

It would have been obvious to one of ordinary skill in the art at the time of the invention to have used the Mueller process in a coal seam, in order to obtain gas, as called for in claim 47.

Regarding independent claim 54:

Mueller teaches the drilling and lightening. Mueller fails to teach the horizontal bore. Mueller also does not specify a specific formation type for the drilling method and thus fails to explicitly teach the drilling in a coal seam, but teaches that the method is useful to prevent overbalanced well problems.

Stanley teaches that overbalanced well problems are common in drilling coal seams; and teaches that it is desirable to drill in coal seams to obtain gas. Stanley also

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teaches that horizontal bores are useful in coal gas wells, in order to increase production.

It would have been obvious to one of ordinary skill in the art at the time of the invention to have used the Mueller process in a coal seam, in order to obtain gas, and to have modified the Mueller process to have included drilling a horizontal bore as called for in claim 54, in order to increase production.

Mueller teaches pumping as called for in claim 55.

Mueller teaches pumping using a downhole pump as called for in claim 56.

6. Claims 26, 28-30, 35-37, 53-55, 57, 58, 59, 60, and 62 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith in view of Stanley.

Smith teaches pumping and reducing pressure. Smith does not teach a specific formation type for the drilling method and thus fails to explicitly teach the drilling in a coal seam, but teaches that the method is useful in a "formation 3 from which one or more minerals such as oil, natural gas...".

Stanley teaches that coal has natural gas.

It would have been obvious to one of ordinary skill in the art at the time of the invention to have used the Smith method in a coal seam as called for in claim 26; in order to get coal gas.

Smith teaches reducing pressure by gas lift as called for in claim 28.

Smith teaches reducing pressure by aerating the fluid(i.e. by gas lift) as called for in claim 29.

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Smith teaches reducing pressure by circulating compressed air(i.e. by gas lift) as called for in claim 30.

Regarding new claim 59: Smith clearly teaches drilling mud.

Regarding independent claim 35:

Smith teaches drilling a well including a horizontal bore and reducing pressure. Smith does not teach a specific formation type for the drilling method and thus fails to explicitly teach the drilling in a coal seam, but teaches that the method is useful in a "formation 3 from which one or more minerals such as oil, natural gas...".

Stanley teaches that coal has natural gas.

It would have been obvious to one of ordinary skill in the art at the time of the invention to have used the Smith method in a coal seam as called for in claim 35; in order to get coal gas.

Smith teaches a pattern including a horizontal bore as called for in claim 36.

Smith also teaches reducing pressure as called for in claim 37.

Regarding new claim 60: Smith clearly teaches drilling mud.

Regarding independent claim 53:

Smith teaches drilling a horizontal bore and pumping fluid and cuttings. Smith does not teach a specific formation type for the drilling method and thus fails to explicitly teach the drilling in a coal seam, but teaches that the method is useful in a "formation 3 from which one or more minerals such as oil, natural gas...".

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Stanley teaches that coal has natural gas.

It would have been obvious to one of ordinary skill in the art at the time of the invention to have used the Smith method in a coal seam as called for in claim 53; in order to get coal gas.

Regarding independent claim 54:

Smith teaches drilling a horizontal bore and lightening pressure. Smith does not teach a specific formation type for the drilling method and thus fails to explicitly teach the drilling in a coal seam, but teaches that the method is useful in a "formation 3 from which one or more minerals such as oil, natural gas...".

Stanley teaches that coal has natural gas.

It would have been obvious to one of ordinary skill in the art at the time of the invention to have used the Smith method in a coal seam as called for in claim 54; in order to get coal gas.

Smith teaches lightening by pumping as called for in claim 55.

Smith teaches lightening by gas lift as called for in claim 57.

Smith teaches pumping through a second bore (2) as called for in claim 58.

Regarding new claim 62: Smith clearly teaches drilling mud.

Response to Arguments

7. Applicant's arguments filed 12/30/04 have been fully considered but they are not persuasive.

Applicant's arguments with respect to claims 40-45, 48-52 have been considered but are moot in view of the new ground(s) of rejection.

With regards to the Stanley reference and the 102 rejections; Stanley clearly discloses liquid in the drilling fluid (col. 3, line 32).

With regards to the obviousness rejections; applicant has asserted that Stanley teaches away from using drilling fluid comprising liquid. First, Stanley teaches (col. 3, line 33) a fluid comprising liquid. Insofar as this line of argument also pertains to new claims explicitly calling for drilling mud; this is not persuasive, Stanley is cited in these rejections for the teaching that gas is present in coal seams; and that it is desirable to drill in coal seams to obtain gas. Mueller, Allen, and Smith fail to teach the nature of the formation to be drilled. It is further noted that Mueller and Allen explicitly state that their processes reduce formation damage.

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any


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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Kreck whose telephone number is 571-272-7042. The examiner can normally be reached on M-F 5:30 am - 2:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Shackelford can be reached on 571-272-7049. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


John Kreck
Primary Examiner
Art Unit 3673

JOHN KRECK
PRIMARY EXAMINER

3/28/05